Remarks

This is in response to the Office Action mailed March 24, 2003. Claims 2, 5, 20, 23, 31 and 34 have been canceled. Claims 1, 16, 29 and 42 have been amended.

I. Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner has rejected claims 1-42 under 35 U.S.C.§112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner contends that the expression "without other non-metallocene catalyzed random copolymers" is a negative limitation, which is not supported directly or conceptually by the specification as originally filed. Applicants have amended claims 1, 16, 29 and 42 to remove the objectionable language. Accordingly, the rejection under 35 U.S.C. §112, first paragraph, should be withdrawn.

II. Rejection Under 35 U.S.C. §112, Second Paragraph

Claims 1-42 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner contends the phrase "formed from a random copolymer of propylene and ethylene prepared using a metallocene catalyst useful in the polymerization of isotactic polypropylene" is confusing. Applicants have amended claims 1, 16, 29 and 42 to remove the objectionable language and replaced this phrase with "metallocene catalyzed, isotactic ethylene-propylene copolymer having a random comonomer distribution", as suggested by the Examiner. Accordingly, the rejection under 35 U.S.C. §112, second paragraph, should be withdrawn.

III. Additional claim amendments

In response to Examiners mention of JP-11-060833 as a prior art reference, Applicants further have incorporated the limitations of "the ethylene present in the ethylene-propylene copolymer in an amount of from about 0.5% to about 30% by weight, wherein the ethylene-propylene copolymer has a DSC melting point temperature of less than about 125° C" into the pending independent claims". These additional limitations clearly distinguish the pending amended claims from the teachings of JP-11-060833.

Discussions regarding previous 35 U.S.C. §102(b) and §103(a) rejections follow.

IV. Previous Rejection Under 35 U.S.C. §102(b)

An invention is said to be "anticipated" only if each and every element set forth in the claim is found, either expressly or inherently, within a single prior art reference. *Verdegall Bros. V. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The fact that a certain characteristic *may* occur or be present in the prior art is not sufficient to establish inherency of that characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993) (*emphasis added*). Mere possibilities or even probabilities are not enough to establish inherency. *See Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991).

The Examiner had previously rejected claims 1-9, 11-15 and 42 under 35 U.S.C. §102(b) as being anticipated by JP-11-060833. This reference, however, discloses materials that are entirely different from Applicants'. Specifically, JP-11-060833 only discloses materials having melting point temperatures of greater than 125°C (See first column of Table 1). Applicants' independent claims specify melting point temperatures that are lower than this. This is supported in the specification at page 14, lines 25-28, and in Table 1 (Product #4) and Table 4 (MRCP-4). Additional claimed properties, such as haze, gloss, xylene solubles, etc. are also not shown or taught by the JP-11-060833 reference nor could it be argued that these are inherent within the disclosed materials of JP-11-060833 as the Japanese reference is directed to a blend of two different materials

that differ from Applicants' material. Accordingly, this reference fails as an anticipatory reference.

The Examiner has previously rejected claims 1-42 under 35 U.S.C. §102(b) based upon EP 0-669-348 A1. This reference, however, specifically excludes copolymers of ethylene (See page 3, lines 9-11). Applicants' claims require a copolymer of propylene and ethylene. Therefore, this reference also fails as an anticipatory reference and the rejection of claims 1-42 under 35 U.S.C. §102(b) should be withdrawn.

V. Previous Rejection Under 35 U.S.C. §103(a)

The Examiner has previously rejected claims 1-42 under 35 U.S.C. §103(a) based upon the combination of EP 0-669-348 A1 and JP-11-060833.

In order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all of the claim limitations when combined. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974); and MPEP 2143.03.

The combination of EP 0-669-348A1 and JP-11-060833 fail to teach or suggest all of the claim limitations of Applicants' claims and therefore fail to establish a *prima facie* case of obviousness. Specifically, there is no teaching by such combination of a copolymer of propylene and ethylene that has the claimed properties, such as ethylene from about 0.5% to about 30% by weight combined with a melting point temperature of less than about 125° C. Accordingly, the combination of these references fail to establish a prima facie case of obviousness.

VI. Conclusion

Applicants submit that the amended claims are in a condition for allowance. Favorable action is therefore requested. If the Examiner believes that the prosecution of the present application can be expedited by addressing any outstanding issues over the phone, Applicants would invite the Examiner to contact the undersigned at the phone number provided.

No fee or petition for extension of time is believed necessary for this response. If any fees are deemed necessary, the Commissioner is hereby authorized to charge them to Deposit Account No. 03-3345.

All future correspondence with respect to the above-referenced application should be addressed to:

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EXHIBIT "A"

MARKED VERSION OF THE CLAIMS

1. (Currently Amended) A heat-seal polymer film comprising a layer of film formed from a [random copolymer of propylene and ethylene prepared using a metallocene catalyst useful in the polymerization of isotactic polypropylene and without other non-metallocene-catalyzed random copolymers.] metallocene catalyzed, isotactic ethylene-propylene copolymer having a random comonomer distribution, the ethylene present in the ethylene-propylene copolymer in an amount of from about 0.5% to about 30% by weight, wherein the ethylene-propylene copolymer has a DSC melting point temperature of less than about 125°C.

16. (Currently Amended) A multi-layer polymer film comprising a polyolefin core layer and at least one heat-seal layer formed from a [random copolymer of propylene and ethylene prepared using a metallocene catalyst useful in the polymerization of isotactic polypropylene and without other non-metallocene-catalyzed random copolymers] metallocene catalyzed, isotactic ethylene-propylene copolymer having a random comonomer distribution, the ethylene present in the ethylene-propylene copolymer in an amount of from about 0.5% to about 30% by weight, wherein the ethylene-propylene copolymer has a DSC melting point temperature of less than about 125°C that is joined to the polyolefin core layer.

29. (Currently Amended) A material for use in heat-seal applications comprising a [random copolymer of propylene and ethylene prepared using a metallocene catalyst useful in the polymerization of isotactic polypolypropylene and without other non-metallocene-catalyzed random copolymers] metallocene catalyzed, isotactic ethylene-propylene copolymer having a random comonomer distribution, the ethylene present in the ethylene-propylene copolymer in an amount of from about 0.5% to about 30% by

weight, wherein the ethylene-propylene copolymer has a DSC melting point temperature of less than about 125°C.

42. (Currently Amended) A method of forming a heat-seal film comprising:

providing a [random copolymer of propylene and ethylene prepared using a metallocene catalyst useful in the polymerization of isotactic polypropylene without other non-metallocene-catalyzed random copolymers] metallocene catalyzed, isotactic ethylene-propylene copolymer having a random comonomer distribution, the ethylene present in the ethylene-propylene copolymer in an amount of from about 0.5% to about 30% by weight, wherein the ethylene-propylene copolymer has a DSC melting point temperature of less than about 125° C; and

forming the [random] copolymer into a layer of film.